

08-26-03 #10
PEAR AVENUE, INC.

1077 Clematis Drive, Sunnyvale, CA 94086 - 650 967 5477



UTILITY PATENT APPLICATION 09/504327

**PETITION UNDER 37 CFR § 1.181(A) REQUESTING WITHDRAWAL OF THE
HOLDING OF ABANDONMENT per MPEP 711.03(A)**

Mail Stop: Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Technology Center 2100

August 25th, 2003

Sir:

With reference to Office Action **Notice of Abandonment** (copy attached) dated 26th June, 2003 by Examiner Raymond J Bayerl of **Art Unit 2173** on **application serial number 09/504327** entitled:

**INTERACTIVE MULTI MEDIA USER INTERFACE
USING AFFINITY BASED CATEGORIZATION**

Summary

We have complied with all date requirements and made bona fide and complete attempts to respond to the office actions.

Our response to a NON-COMPLIANT AMENDMENT notice dated 16th April, 2003 requesting a marked up version of the amended paragraphs and a marked up version of the amended claims **did not correctly separate the amended claims from the body of the substitute specification submitted.**

The examiner held the filing abandoned because he was unable to process the contiguous parts together through technical support staff. Because entry failed though our response was substantially complete, the examiner did not issue a request for omission of missing parts as required by **37 CFR 1.135(c)** and allow us time to modify the response.

Our response was a bonafide attempt to respond. The failure to separate the substitute specification from the amended claims was a material omission on our part and according to by **37 CFR 1.135(c)** we are permitted time to redress this omission.

We therefore respectfully request that the holding of abandonment be withdrawn. The corrected form of our application is enclosed.

Documented Details

1. September, 5th 2002: FIRST OFFICE ACTION (copy enclosed).
2. March 4th: OUR RESPONSE TO THE FIRST OFFICE ACTION including point by point response to examiners analysis (copy enclosed).
3. April 16th, 2003: OFFICE ACTION NON-COMPLIANT AMENDMENT (copy enclosed).

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4. May 15th, 2003: RESPONSE TO NON-COMPLIANT AMENDMENT – request for marked up amendments and claims enclosed here in correct form with marked up substitute specification and marked up claims correctly presented.
5. JUNE 26th, 2003: NOTICE OF HOLDING OF ABANDONMENT (copy enclosed)
6. July 3rd, 2003: TELEPHONE DISCUSSION WITH EXAMINER BAYERL FOR CLARIFICATION OF ABANDONMENT ISSUE

I spoke with Examiner Bayerl on July 3rd, 2003 by telephone to clarify the matter and the following is my understanding:

The examiner took the submission to technical support staff for data entry and the **entry could not be made** with the substitute specification and the amended claims contiguous.

Accordingly, the Examiner observed MPEP 608.01(q) – the substitute specification does not comply with 37 CFR 125 and **the examiner held the reply insufficient because entry could not be made**. Ambiguity exists in the MPEP regarding the course of action to take when the submission is presented in this way – i.e., the submission had no omission of parts but has an omission of order, what should have been presented in two parts was presented as one.

7. August 25, 2003 - **OUR RESPONSE TODAY**

By failing to separate the substitute specification from the amended claims we made an inadvertent material omission, 37 CFR 1.135(c) allows us the opportunity to correct this omission to avoid abandonment.

Our response today is within the two months specified in **37 CFR § 1.181(f)** to petition the commissioner. The inventor has prepared this response and this time was required to allow a full review the MPEP, CFR, and U.S.C. sections relevant in this matter.

We respectfully request that the holding of abandonment be withdrawn and that the attached response now be examined with all expediency for the merit of its content.

Enclosed is a complete copy of all relevant parts of the earlier filing, correctly partitioned.

Number of pages in the response to the examiner: 32

Number of pages in marked up substitute specification: 39

Number of pages of amended claims: 6

Number of claims: 17 – 7 are amended.

Number of drawings: 12

Enclosed are:

[X] Marked-up amended substitute specification 40 pages

[X] Marked-up amended claims 6 pages

[X] Statement that no new matter is included in the amendments.

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- [X] Drawings 12 pages
- [X] Detailed Response to Examiner 32 pages
- [X] Copy of the April 16th Notice of Non-Compliant Amendment
- [X] Copy of the June 26th Notice of Abandonment
- [X] Copy of USPTO receipts with OIPE stamps confirming dates.

This package mailed with Express Mail Certificate No. EU 960866741 US

Date Mailed: August 25, 2003

Please direct all correspondence concerning this petition to myself, the inventor:

Dr. Steven Ericsson Zenith

PEAR AVENUE, INC.

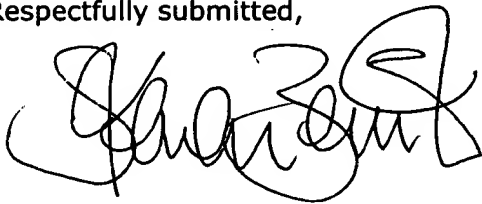
1077 Clematis Drive,

Sunnyvale, CA 94086

(408) 246 1551

steven@pearavenue.com

Respectfully submitted,

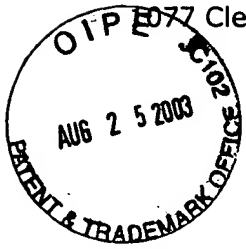
A handwritten signature in black ink, appearing to read 'Steven Zenith', with a large, stylized 'Z' and 'E' at the end.

Dr. Steven Ericsson Zenith

August 25th, 2003

PEAR AVENUE, INC.

2077 Clematis Drive, Sunnyvale, CA 94086 - 650 967 5477



UTILITY PATENT APPLICATION 09/504327

THE AMENDMENTS SPECIFIED INCLUDE NO NEW MATTER

Mail Stop Non-Fee Amendments
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

May 15th, 2003

Sir:

With reference to Office Action dated 5th September, 2002 by Examiner Raymond J Bayerl of **Art Unit 2173** on application serial number 09/504327 entitled:

**INTERACTIVE MULTI MEDIA USER INTERFACE
USING AFFINITY BASED CATEGORIZATION**

With respect to the **response to the Office Action** regarding this application filed March 4th, the **amendment to the drawings and specification** plus the **currently enclosed marked up substitute specification and amended claims**, the amendments I have specified include **no new matter**.

Respectfully submitted,

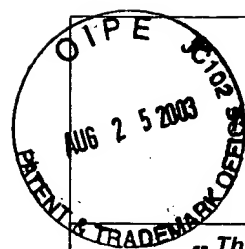
Dr. Steven Ericsson Zenith

May 15th, 2003

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Notice of Abandonment

Application No.

09/504,327

Applicant(s)

ZENITH, DR. STEVEN
ERICSSON

Examiner

Raymond J. Bayerl

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 10 September 2002.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☒ A reply was received on 15 May, 4 Mar 2003 but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☐ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☒ The reason(s) below:

Applicant's 15 May 2003 substitute specification, 45 pages including claims, was not required by the PTO. 37 CFR 1.125(b) does not afford this option as a matter of right. Therefore, the responses offered are insufficient in reply to the 10 September 2002 office action. See MPEP 608.01(q).

RAYMOND J. BAYERL
PRIMARY EXAMINER

ART UNIT 2173

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

26 June 2003



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov



Paper No. 8

Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment filed on 4 Mar 2003 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on September 8, 2000 (see *65 Fed. Reg. 54603*, Sept. 8, 2000, and *1238 O.G. 77*, Sept. 19, 2000). In order for the amendment to be compliant, applicant must supply the following omissions or corrections in reply to this notice.

THE FOLLOWING ITEMS ARE REQUIRED FOR COMPLIANCE WITH RULE 1.121 (APPLICANT NEED NOT RE-SUBMIT THE ENTIRE AMENDMENT):

- ☐ 1. A clean version of the replacement paragraph(s)/section(s) is required. See 37 CFR 1.121(b)(1)(ii).
- ☒ 2. A marked-up version of the replacement paragraph(s)/section(s) is required. See 37 CFR 1.121(b)(1)(iii).
- ☐ 3. A clean version of the amended claim(s) is required. See 37 CFR 1.121(c)(1)(i).
- ☒ 4. A marked-up version of the amended claim(s) is required. See 37 CFR 1.121(c)(1)(ii).

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Explanation: Applicant has filed a substitute specification and claims in response to the 10 Sept 2002 Office action. However, 37 CFR 1.125 does not provide for voluntary substitution
(LIE: Please provide specific details for correction to assist the applicant. For example, "the clean version of claim 6 is missing.") involving claims changes. Also, there is no marked up copy (if filed under 37 CFR 1.121), or statement that no new matter is included.
See MPEP 608.01(q)

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at <http://www.uspto.gov/web/offices/dcom/olia/pbg/sampleaf.pdf>. A condensed version of a sample amendment format is attached.

- ☐ **PRELIMINARY AMENDMENT:** Unless applicant supplies the omission or correction to the preliminary amendment in compliance with revised 37 CFR 1.121 noted above within ONE MONTH of the mail date of this letter, examination on the merits may commence without entry of the originally proposed preliminary amendment. This notice is not an action under 35 U.S.C. 132, and this ONE MONTH time limit is not extendable.
- ☒ **AMENDMENT AFTER NON-FINAL ACTION:** Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of ONE MONTH or THIRTY DAYS from the mailing of this notice, whichever is longer, within which to supply the omission or correction noted above in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Legal Instruments Examiner (LIE)

(Rev. 12/01)

RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2173
16 April 2003



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Amended Patent Application:

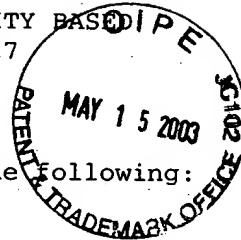
INTERACTIVE MULTI MEDIA USER INTERFACE USING AFFINITY BASED
CATEGORIZATION, USPTO APPLICATION SERIAL # 09/504327

RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT

Please stamp and confirm receipt in the USPTO of the following:

- [X] Amended Specification 39 pages, 45 pages including claims.
- [X] Amended Claims 6 pages
- [X] Statement that no new matter is included in the amendments.

Express Mail Certificate No. **EU31373516205**
Date Mailed: May 15, 2003



Amended Patent Application:

INTERACTIVE MULTI MEDIA USER INTERFACE USING AFFINITY BASED
CATEGORIZATION, USPTO APPLICATION SERIAL # 09/504327

Please stamp and confirm receipt in the USPTO of the following:

- [X] Amended Specification and Abstract 38 pages
44 including claims
- [X] Claims 6 pages
- [X] Drawings 12 pages
- [X] Detailed Response to Examiner 32 pages
Examiner: BAYERL, RAYMOND J / Art Unit 2173
- [X] Change of Correspondence Address, PTO Form SB/122
- [X] Credit Card Payment Form PTO 2038
- [X] Petition for Extension of Time Under 37 CFR 1.136a:
3 months, Fee \$465.00, Small Entity

Express Mail Certificate No. EU627590280US
Date Mailed: March 4, 2003

